

In Re Application of: Way, Frederick L. II
Serial No.: 09/686,235
Filed: October 11, 2000
For: Gravity Driven Steerable Vehicle

Group Art Unit: 3618
Examiner: Glebe, G.
Dkt. No: TS097-cipSLED
Paper No. 3

what he has perceived to be five inventions characterized as Groups I - V. Group I, define the four-wheeled embodiment shown in Figs. 1, 2, 4-10, 14 and 15; Group II, define the three-wheeled embodiment shown in Fig. 3; Group III, define the embodiment having skis at the front, wheels rear shown in Fig. 11; Group IV, define the embodiment having skis at the front, and skis at the rear shown in Fig. 12; and Group V, define the embodiment having skis at the front, and a slide pan at the rear shown in Fig. 13.

In paragraph 2 of Examiner's office action, examiner states that a phone call from Examiner to Mr. Dishong to request an oral election did not result in an election. The election with traverse to prosecute the claims of the species of group IV is hereby affirmed.

As noted by the Examiner, upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species in addition to the elected species, provided that all claims to each additional species are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141.

Remarks:

Examiner has required a restriction of applicant's invention under 35 U.S.C. § 121. Applicants have elected, with traverse, to prosecute the invention defined by the claims of group IV, the claims drawn to the embodiment of Fig. 12. Applicants respectfully request Examiner to withdraw this requirement for restriction of the application and submits that the invention of Group IV and the inventions of Group I, Group II, Group III and Group V are each patentably distinct inventions and each is defined by all of the claims 1-28 as amended herewith. Claim 1, Applicants respectfully submit, is generic and reads on all of the 5 species.

In paragraph 1 of Examiner's office action, Examiner suggests that there are claims directed to 5 patentably distinct species of the claimed invention. Applicants acknowledge the requirement for restriction made in paragraph 3 of the office action and elects with traverse to prosecute the invention of group IV. Pursuant to paragraph 4 requirements Applicants presently finds that claims 8, 9, 10, 12, 14, 16-19, 27 and 28 as herewith amended, and the claims upon which they depend, appear to be readable on the species of the elected Group IV. It is further noted that Examiner suggests that it appears to be no allowable generic claim.

In response to Examiner's reasons for the restriction requirement of paragraph 4, applicant has provided the following remarks relative to the inventions defined by the claims as amended.

Applicant respectfully notes that in order for a requirement for a restriction to be proper, there must exist two (or more) independent and distinct inventions claimed in a single application. 37 C.F.R. § 142. First, applicant respectfully contends that the 5 inventions, are patentably distinct but they are dependent because the elements recited in the claim 1 as filed reads on all of

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the species identified by Examiner. The relevant elements of claim 1 are: -

“at least one but not more than two rear wheel hub and spindle assemblies integral with said rear axle assembly;
at least one but not more than two front wheel hub and spindle assemblies integral with said front axle assembly; and
further comprising means for retrofitting said gravity driven steerable wheeled vehicle with at least one ski assembleable to at least one of said at least one but not more than two rear wheel hub and spindle assemblies and said at least one but not more than two front wheel hub and spindle assemblies.”

This claim 1 clearly defines the invention as having generally 3 or 4 hub assemblies (not wheels or skis) and 3 or 4 means for putting 3 or 4 wheels or 3 or 4 skis (again not wheels or skis) in place of wheels onto each of the 3 or 4 hub assemblies which 3 or 4 wheels or skis may be configured to be all wheels or all skis or skis front or rear - i.e., no wheels or skis are included in the features of the claim 1 only the means for putting them onto the hub assemblies.

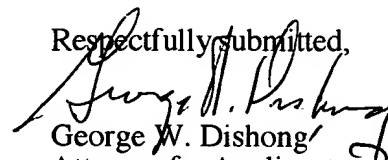
Applicants submit that the species are patentably distinct but all 5 of the identified species are defined by all of the claims of the application.

Conclusion:

Applicant respectfully submits that the patentably distinct but related inventions defined in claims 1 - 28 should be prosecuted in one application and therefore Applicant request Examiner to withdraw the requirement to restrict the application to one of the defined Groups I - V. Applicant further submits that the application is in condition for allowance and early notice of allowance is requested. The fees associated with this response, if there are any due, are included herewith. Applicant respectfully requests that Examiner contact his attorney by telephone or by facsimile if there are any additional questions relative to this patent application.

George W. Dishong
DISHONG LAW OFFICES
40 Bryant Road
Jaffrey, New Hampshire 03452
Tel # 603-532-7206; Fax # 603-532-7303; Email dishongpatlaw@monad.net

Respectfully submitted,


George W. Dishong
Attorney for Applicant
Reg. No. 31,348